



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Hoover et al. Examiner: Rosen, N.
Serial No.: 09/307,261 Group Art Unit: 3625
Filed: May 6, 1999 Docket No.: JARB.007PA
Title: PREVIEWING SYSTEM AND METHOD

#10 Brief
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited, in triplicate, in the United States Postal Service, as first class mail, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on February 14, 2003.

By: Erin M. Nichols
Erin M. Nichols

APPEAL BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

This is an Appeal Brief submitted pursuant to 37 CFR §1.192 for the above-referenced patent application and is being filed in triplicate.

I. Real Party in Interest

The real party in interest is Jarbridge Inc., having a place of business at 1101 West River Drive, Suite 130, Boise, Idaho 83702. The above referenced patent application is assigned to Jarbridge, Inc.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of Claims

Appellant hereby cancels claims 25-35, 59-77 and 80-83 leaving claims 1-2, 4-24 and 36-58 remaining and presented for appeal. Claims 1-2, 4-5, 8-12 and 67 stand rejected under §103(a) as being unpatentable over *Fay* (U.S. Pat. No. 5,983,201) in view of *Dias et al.* (U.S. Pat. No. 6,170,017); claims 6 and 7 stand rejected under §103(a) as being unpatentable over *Fay* and *Dias et*

al. and further in view of *Maloomian* (U.S. Pat. No. 4,261,012); claims 82 and 83 stand rejected under §103(a) as being unpatentable over *Fay* and *Dias et al.* and further in view of *Brush, II et al.* (U.S. Pat. No. 5,884,029); claims 13-16, 19-24 and 68 stand rejected under §103(a) as being unpatentable over *Fay* in view of *Dias et al.*; claims 17 and 18 stand rejected under §103(a) as being unpatentable over *Fay* and *Dias et al.* and further in view of *Maloomian*; claims 25-26, 28-34 and 69 stand rejected under §103(a) as being unpatentable over *Fay* in view of *Hill* (U.S. Pat. No. 5,970,471); claim 27 stands rejected under §103(a) as being unpatentable over *Fay* and further in view of *Hill*; claim 35 stands rejected under §103(a) as being unpatentable over *Fay* and *Hill* and further in view of the *Brown* article "Macy's eases Swimsuit Fear with Database;" claims 36-42, 43-50, 70 and 71 stand rejected under §103(a) as being unpatentable over *Fay* in view of *Dias et al.*; claims 51-58, 59-66 and 72 stand rejected under §103(a) as being unpatentable over *Fay* in view of *Hill*; claims 73-76, 77, and 80 stand rejected under §103(a) as being unpatentable over *Fay* in view of *Dias et al.*; and claim 81 stands rejected under §103(a) as being unpatentable over *Fay* and further in view of the *Brown* article "Macy's eases Swimsuit Fear with Database."

IV. Status of Amendments

The application was initially filed on May 6, 1999 including claims 1-83. In reply to the first Office Action mailed on February 19, 2002, an Office Action Response and Amendment was filed on May 20, 2002, *inter alia*, canceling claims 78 and 79 and amending claims 1, 3, 13, 19, 25, 36, 39, 43, 51, 59, 73, 77 and 80. A second Office Action was mailed on August 19, 2002, wherein claim 3 was allowed, and in reply a Notice of Appeal was filed on November 14, 2002.

V. Summary of Invention

One embodiment of the present invention is directed to a method for previewing an accessory. The method includes providing data of a first image, which includes at least a portion of an intended recipient of the accessory to a server computer. The server computer is linked to different accessory-provider computer sites, where the sites have different accessories available for viewing. A second image is selected from an electronic database of images, where the second image is an image of one of the accessories to be worn on the portion of the intended recipient in the first image. Data is generated of a composite image illustrating the accessory

being worn on said portion from the data of the first image and data of the second image with the server computer. Data of the composite image is transmitted from the server computer to a client computer. The composite image is then displayed on an output device in communication with the client computer.

Another embodiment of the instant invention is directed to a system for previewing an accessory. The system includes an input device for receiving a first image, which includes an image of at least a portion of a person and a client computer which is operatively coupled to the input device. Also included is a server computer that is linked to different accessory-provider computer sites respectively having different accessories; the server computer is also operatively coupled to the client computer. The server computer has a first computer program for selecting data of a second image from an electronic database of images and a second computer program for generating data of a composite image illustrating an accessory being worn on the portion of the person shown in the first image from data of the first image and data of the second image. An output device which is operatively coupled to the client computer is also included to display the composite image. In the system, the input device, client computer, and output device are at a first location and the server computer is located at a second location.

Another embodiment of the present invention is directed to a system for previewing an accessory before purchasing the accessory. The system includes a server having a first computer program for selecting data of a first accessory image from an electronic database, a second computer program for generating data of a first composite image from data of the first accessory image and data of the person's image, a third computer program for selecting data of a second accessory image from the electronic database, and a fourth computer program for generating data of a second composite image from the data of the second accessory image and data of the person's image. The system further includes an information storage medium on or accessible to the server computer for saving data of the first composite image, a client computer operatively coupled with the server computer, and a display device. The display device displays the first and second composite images, one of which shows one of the accessories being worn on the person, to a customer for simultaneously previewing accessories before purchasing.

VI. Issues for Review

Issue 1: Is the §103(a) rejection of claims 1-2 and 4-24, proper when the Examiner failed to present prior art correspondence and evidence of motivation to combine the asserted references?

Issue 2: Is the §103(a) rejection of claims 36-50 proper when the Examiner failed to present prior art correspondence and evidence of motivation to combine the asserted references?

Issue 3: Is the §103(a) rejection of claims 51-58 proper when the Examiner failed to present prior art correspondence and evidence of motivation to combine the asserted references?

VII. Grouping of Claims

The claims as now presented do not stand and fall together and are separately patentable for the reasons discussed in the Argument. For purposes of this appeal, the claims should be grouped as follows: Group I - claims 1-2, and 4-24; Group II – claims 36-50; and Group III – claims 51-58.

XIII. Argument

Appellant submits that the claims of groups I – III are patentably distinguishable from each other and from the cited prior art references. The claims in group I are patentable over the prior art, because they include subject matter directed to a server computer that generates a composite image showing a first image wearing a second image, which is not taught or suggested by any of the references cited. The claims of group II are separately patentable over the other claim groups because they are directed to subject matter that includes a server computer having a computer program for generating data of a composite image illustrating an accessory worn on a first image, which is not necessarily present in the other claim groups and not taught by the cited prior art. The claims of group III are separately patentable over the other claim groups because they are directed to subject matter that includes an information storage medium on or accessible to the server computer for saving data of a first composite image, which is not necessarily present in the other claim groups and not taught by the cited prior art.

Issue 1: The §103(a) rejection of claims 1-2 and 4-24 is not proper when the Examiner failed to present prior art correspondence and evidence of motivation to combine the asserted references.

A. Failure to Present Prior Art Correspondence

In the final Office Action dated August 19, 2002, the Examiner failed to present (or even assert) a combination of references that teaches or suggests every claimed limitation of the present invention. Both independent claims 1 and 13, are directed to a method for previewing an accessory including, *inter alia*, establishing a server computer between different accessory-provider computer sites and a client computer at a first location and using the server computer to generate data of a composite image from a first image (*e.g.*, a person) and a second image, where the composite image includes an accessory worn on, *e.g.* the person, shown in the first image. At page 7 of the Office Action, the Examiner acknowledges that the '201 reference fails even to disclose a server computer. While the Examiner cites a portion of the '017 reference as teaching a server computer, no further assertion was made by the Examiner that any such prior-art server computer generates data of such a composite image having a first image wearing a second image. At best, the Examiner's combination would provide a server in the '201 embodiment but without the server generating the claimed composite image. The Examiner's failure to present prior art correspondence or even the assertion thereof is insufficient to support a §103(a) rejection and the rejection must be removed.

B. Failure to Present Evidence of Motivation

The U.S. Patent Laws require actual evidence that the prior art suggests modifying the references in order to obtain the Examiner's proposed combination. In this instance, the Examiner suggests that the '201 reference should include a server computer at a second location for coordinating authentication of a client among a set of stores, integrating information from multiple stores, and coordinating requests for group transactions from multiple stores. No evidence was cited in support of this assertion that the prior art would lead a skilled artisan to so modify the '201 reference. Moreover, none of these unsupported suggestions are directed to a server computer generating data of a composite image showing a first image wearing a second

image. Without such evidence, the §103(a) rejection is unmotivated. *See, e.g., In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

More recent case law has more explicitly defined that the evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification: “Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, ‘leading inventors to look to *references* relating to possible solutions to that problem.’” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000). The Office Action does not provide any evidence of factual teachings, suggestions or incentives from the prior art that would lead to the proposed modification. Therefore, a *prima facie* case of obviousness has not been established, and the §103(a) rejections must be removed.

As is apparent from the silence on this issue at page 7 of the Office Action, no evidence has been presented to support the Examiner’s theory that the skilled artisan would be led by the prior art to modify the ‘201 reference as asserted via the Examiner’s opinion. Moreover, in view of the above subheading “A” above, no evidence has been presented that the skilled artisan would be motivated to further modify the ‘201 reference because no prior art teaches a server computer generating data of a composite image showing a first image wearing a second image.

With respect to the Examiner’s Response to Challenges of Official Notice, Appellant acknowledges the numerous citations provided. No evidence has been cited to support that the prior art would lead the skilled artisan to make the proposed modifications. Such evidence of the references’ combinability (under §103) with the teachings of the ‘201 reference is required under §103 to sustain such a rejection.

Issue 2: The §103(a) rejection of claims 36-50 is not proper when the Examiner failed to present prior art correspondence and evidence of motivation to combine the asserted references.

A. Failure to Present Prior Art Correspondence

The Examiner failed to present (or even assert) a combination of references that teaches or suggests every claimed limitation of the present invention. Both independent claims 36 and 43, are directed to a system for previewing an accessory including, *inter alia*, a server computer

comprising a computer program that generates data of a composite image illustrating a first image (a recipient) wearing a second image (an accessory). At pages 20 and 23 of the Office Action, the Examiner acknowledges that the '201 reference fails to disclose a server computer. While the Examiner cites a portion of the '017 reference as teaching a server computer, no further assertion was made by the Examiner that any such prior-art server computer includes a computer program that generates data of such a composite image illustrating a first image (a recipient) wearing a second image (an accessory). As with the previously-discussed rejection, the Examiner's combination would at best provide a server in the '201 embodiment but without the server having a program adapted to generate the claimed composite image. The Examiner's failure to present prior art correspondence or even the assertion thereof is insufficient to support a §103(a) rejection and the rejection must be removed.

B. Failure to Present Evidence of Motivation

The U.S. Patent Laws require actual evidence that the prior art suggests modifying the references in order to obtain the Examiner's proposed combination. In this instance, the Examiner suggests that the '201 reference should include a server computer at a second location for coordinating authentication of a client among a set of stores, integrating information from multiple stores, and coordinating requests for group transactions from multiple stores. No evidence was cited in support of this assertion that the prior art would lead a skilled artisan to so modify the '201 reference. Moreover, none of these unsupported suggestions are directed to a server computer having a computer program that generates data of a composite image illustrating a first image (a recipient) wearing a second image (an accessory). Without such evidence, the §103(a) rejection is unmotivated. *See, e.g., In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

More recent case law has more explicitly defined that the evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification: "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" *Ruiz v. A.B. Chance Co.*, 234

F.3 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000). The Office Action does not provide any evidence of factual teachings, suggestions or incentives from the prior art that would lead to the proposed modification. Therefore, a *prima facie* case of obviousness has not been established, and the §103(a) rejections must be removed.

As is apparent from the silence on this issue at pages 20 and 23 of the Office Action, no evidence has been presented to support the Examiner's theory that the skilled artisan would be led by the prior art to modify the '201 reference as asserted via the Examiner's opinion. Moreover, in view of subheading "A" above, no evidence has been presented that the skilled artisan would be motivated to further modify the '201 reference because no prior art teaches a server computer having a computer program that generates data of a composite image illustrating a first image (a recipient) wearing a second image (an accessory).

Issue 3: The §103(a) rejection of claims 51-58 is not proper when the Examiner failed to present prior art correspondence and evidence of motivation to combine the asserted references.

A. Failure to Present Prior Art Correspondence

The Examiner failed to present (or even assert) a combination of references that teaches or suggests every claimed limitation of the present invention. Independent claim 51, is directed to a system for previewing an accessory before purchasing the accessory including, *inter alia*, a server computer having: (a) a computer program that generates data of a second composite image of a first image (person) wearing a second accessory image; and (b) an information storage medium on or accessible to the server computer for saving data of the first composite image. At page 26 of the Office Action, the Examiner acknowledges that the '201 reference fails even to disclose a server computer. While the Examiner cites a portion of the '017 reference as teaching a server computer, no further assertion was made by the Examiner that any such prior-art server computer includes a computer program that generates data of a second composite image of a first image (person) wearing a second accessory image. Further, no prior art was asserted that teaches an information storage medium on or accessible to the server computer for saving data of the first composite image. The storage medium of the '201 reference fails to store a composite image, but rather stores a record of accessories. The Examiner's failure to present prior art

correspondence or even the assertion thereof is insufficient to support a §103(a) rejection and the rejection must be removed.

B. Failure to Present Evidence of Motivation

The U.S. Patent Laws require actual evidence that the prior art suggests modifying the references in order to obtain the Examiner's proposed combination. In this instance, the Examiner suggests that the '201 reference should include a server computer at a second location for coordinating authentication of a client among a set of stores, integrating information from multiple stores, and coordinating requests for group transactions from multiple stores. No evidence was cited in support of this assertion that the prior art would lead a skilled artisan to so modify the '201 reference. Moreover, none of these unsupported suggestions are directed to a server computer having a computer program that generates data of a second composite image of a first image (person) wearing a second accessory image, and an information storage medium on or accessible to the server computer for saving data of the first composite image. Without such evidence, the §103(a) rejection is unmotivated. *See, e.g., In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

More recent case law has more explicitly defined that the evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification: "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000). The Office Action does not provide any evidence of factual teachings, suggestions or incentives from the prior art that would lead to the proposed modification. Therefore, a *prima facie* case of obviousness has not been established, and the §103(a) rejections must be removed.

As is apparent from the silence on this issue at page 26 of the Office Action, no evidence has been presented to support the Examiner's theory that the skilled artisan would be led by the prior art to modify the '201 reference as asserted via the Examiner's opinion. Moreover, in view of subheading "A" above, no evidence has been presented that the skilled artisan would be

motivated to further modify the '201 reference because no prior art teaches a server computer having a computer program that generates data of a second composite image of a first image (person) wearing a second accessory image, and an information storage medium on or accessible to the server computer for saving data of the first composite image.

IX. Conclusion

In view of the above, Appellant believes the claimed invention to be patentable and the rejections of Claims 1-2, 4-24 and 36-58 are improper. Appellant respectfully requests reversal of the rejections as applied to the appealed claims and allowance of the entire application.

Also, please find attached a Petition for Extension of Time along with the requisite fee.

Please charge Deposit Account No. 50-0996 (JARB.007PA) in the amount of \$160.00 for filing a Brief in support of an appeal as set forth in §1.17(c).

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Respectfully submitted,

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APPENDIX OF APPEALED CLAIMS

1. A method for previewing an accessory to be worn by a person, the method comprising:
 - providing a first image to an input device at a first location, the first image including at least a portion of the person;
 - transmitting data of the first image to a server computer at a second location, the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing;
 - selecting a second image from an electronic database of images on or accessible to the server computer, the second image comprising an image of one of the accessories to be worn on the portion of the person in the first image;
 - generating data of a composite image from the data of the first image and data of the second image with the server computer, the composite image including the accessory worn on the portion of the person; and
 - displaying the composite image on an output device at the first location.
2. The method of claim 1 wherein transmitting data of the first image to a server computer comprises transmitting the data over the Internet.
4. The method of claim 1 wherein the first image comprises the face of the person, and wherein selecting the second image is performed in accordance with the person's interpupil distance.
5. The method of claim 1 further comprising purchasing the accessory after displaying the composite image.
6. The method of claim 1 further comprising:
 - manipulating data of the first image to modify a size of the first image to correspond to a template having a predetermined size, and wherein selecting the second image comprises using the template to select the second image.

7. The method of claim 1 further comprising:

manipulating data of the first image to modify a size of the first image to correspond to a template having a predetermined size, and wherein generating data of the composite image comprises using data of the template to generate data of the composite image.

8. The method of claim 1 wherein the accessory comprises sunglasses.

9. The method of claim 1 further comprising:

selecting a third image of a background setting prior to generating data of a composite image, and wherein generating data of a composite image comprises generating data of a composite image from the data of the first image, data of the second image, and data of the third image.

10. The method of claim 1 wherein the input device comprises a digital camera.

11. The method of claim 1 wherein the accessory comprises cosmetics or jewelry.

12. The method of claim 1 wherein the first location includes a kiosk.

13. A method for previewing an accessory, the method comprising:

providing data of a first image of at least a portion of an intended recipient of the accessory to a server computer, the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing;

selecting a second image from an electronic database of images, the second image comprising an image of one of the accessories to be worn on the portion of the intended recipient in the first image;

generating data of a composite image illustrating the accessory being worn on said portion from the data of the first image and data of the second image with the server computer;

transmitting the data of the composite image from the server computer to a client computer; and

displaying the composite image on an output device in communication with the client computer.

14. The method of claim 13, wherein the accessory comprises sunglasses.
15. The method of claim 13 wherein the output device is located at the customer's home.
16. The method of claim 13 wherein the computer is located at a kiosk.
17. The method of claim 13 further comprising manipulating data of the first image so that the first image is modified and corresponds to a template.
18. The method of claim 17 further comprising selecting plural accessory images from the database with the template and displaying the plural accessory images.
19. The method of claim 13 wherein transmitting the data of the composite image from the server computer to the client computer comprises transmitting the data of the composite image from the server computer to the client computer via the Internet.
20. The method of claim 19 wherein displaying the composite image on the output device comprises displaying the composite image on a Web page.
21. The method of claim 13 wherein providing data of the first image comprises retrieving data of the first image from an information storage medium on or accessible to the server computer.
22. The method of claim 21 wherein the intended recipient of the accessory is a customer.
23. The method of claim 13 wherein the accessory comprises jewelry or cosmetics.
24. The method of claim 13 further comprising manually entering data of an intended

recipient's body parameters, selecting a plurality of accessory images from the electronic database of images in accordance with the data of the intended recipient's body parameters, and displaying the plurality of accessory images.

36. A system for previewing an accessory, the system comprising:

- an input device for receiving a first image, wherein the first image includes an image of at least a portion of a person;

- a client computer operatively coupled to the input device;

- a server computer including a first computer program for selecting data of a second image from an electronic database of images, the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing, the second image comprising an image of one of the accessories to be worn on the portion of the person in the first image, and a second computer program for generating data of a composite image illustrating the accessory being worn on said portion of a person from data of the first image and data of the second image, wherein the server computer is operatively coupled to the client computer; and

- an output device for displaying the composite image, wherein the output device is operatively coupled to the client computer,

- wherein the input device, client computer, and the output device are at a first location and wherein the server computer is located at a second location.

37. The system of claim 36 wherein the server computer and the client computer are operatively coupled via the Internet.

38. The system of claim 36 further comprising a firewall between the server computer and the client computer.

39. The system of claim 36 further comprising an Internet service provider intermediate between the client computer and the server computer.

40. The system of claim 36 wherein the server computer comprises a third computer

program for processing purchases.

41. The system of claim 36 wherein the accessory comprises sunglasses.

42. The system of claim 36 wherein the server computer comprises a third computer program for selecting a background image from an electronic database of background images.

43. A system for previewing an accessory, the system comprising:

- an information storage medium comprising a first electronic database of images of people;

- a server computer, the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing, and the server computer including (i) a first computer program for selecting a first image from the first electronic database, the first image comprising an image of an intended recipient of an accessory, (ii) a second computer program for selecting a second image from a second electronic database, the second image comprising an image of one of the accessories to be worn on the intended recipient in the first image, and (iii) a third computer program for generating data of a composite image illustrating the accessory being worn on the intended recipient from the data of the first image and data of the second image;

- a client computer for receiving the data of the composite image, wherein the client computer is operatively coupled to the server computer; and

- an output device for displaying the composite image, wherein the output device is operatively coupled to the client computer.

44. The system of claim 43 wherein the client computer and the server computer are operatively coupled via the Internet.

45. The system of claim 43 further comprising an input device operatively coupled to the client computer.

46. The system of claim 43 wherein the accessory comprises sunglasses.

47. The system of claim 43 further comprising a kiosk, wherein the client computer is at the kiosk.

48. The system of claim 43 wherein the server computer further comprises:
a fourth computer program for processing a purchasing transaction.

49. The system of claim 43 wherein the information storage medium includes two or more databases, each of the databases containing different accessories.

50. The system of claim 43 wherein the intended recipient is a customer.

51. A system for previewing an accessory before purchasing the accessory, the system comprising:

a server computer comprising (i) a first computer program for selecting data of a first accessory image from an electronic database, (ii) a second computer program for generating data of a first composite image from data of the first accessory image and data of a person's image, (iii) a third computer program for selecting data of a second accessory image from the electronic database, and (iv) a fourth computer program for generating data of a second composite image from data of the second accessory image and data of the person's image;

an information storage medium for saving data of the first composite image, the information storage medium being on or accessible to the server computer;

a client computer operatively coupled with the server computer; and

a display device for displaying the first and second composite images to a customer for simultaneously previewing accessories before purchasing, at least one of the composite images showing one of the accessories being worn on the person.

52. The system of claim 51 wherein the server computer and the client computer are operatively coupled via the Internet.

53. The system of claim 51, wherein the server computer further comprises a fifth

computer program for processing the sale of an accessory.

54. The system of claim 51 further comprising a firewall between the server computer and the client computer.

55. The system of claim 51 further comprising an input device operatively coupled to the client computer.

56. The system of claim 51 wherein the client computer is located at a kiosk.

57. The system of claim 56 wherein the kiosk contains accessories for sale.

58. The system of claim 51 wherein the client computer comprises a Web browser computer program.